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Statement
6-18-91

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

In re Application of:)	Group Art Unit: 291
ANTHONY MAGLICA)	Examiner: M. Tung
Serial No.: 07/411,576)	
Filed: September 22, 1989)	
For: CANDLE MODE FLASHLIGHT)	

INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR § 1.56

Honorable Commissioner of Patents
and Trademarks
Washington, D. C. 20231

Sir:

The following presents a substantial body of information which is compelled by the requirements for a full disclosure under 37 C.F.R. § 1.56. To no small degree, the extent of this material is due to the very substantial commercial success and outstanding market acceptance of the wholly novel utilitarian and aesthetic designs. This success has resulted in substantial infringements of the Applicant's rights through copying and otherwise which has, in turn, given rise to litigation and the presentation of a large body of information asserted by various infringers to be material.

Applicant has previously submitted copies of the documents referred to herein and identified on the PTO Form

1449 to the same Examiner in October of 1990 on another matter. The record indicates that the documents have been fully considered but in the context of another application. Because of the large volume of material it would appear most convenient for both the Examiner and the Applicant if the copies already presented to the Examiner be reviewed for the present application. If the Examiner has dispersed the art or otherwise requires another copy, Applicant requests a telephone call to the undersigned in order that copies may be promptly provided.

Recognizing the burden this body of information places on the Examiner, Applicant offers an interview with the Examiner to help review and/or develop a plan for dealing with same. Again, please contact the undersigned.

The following is submitted pursuant to MPEP Sections 2001.06(b) and 2001.06(c), and in doing so also constitutes a submission under MPEP Section 2001.06(b), in compliance with Applicant's duty of disclosure under 37 CFR § 1.56. The documents identified in PTO Form 1449 and arranged in the respective groupings are specified in compliance with the requirements of 37 CFR 1.98 with the understanding that the Examiner will nevertheless make a thorough investigation of the available information in accordance with 37 CFR 1.104.

A. Information Submitted Pursuant to MPEP 2001.06(b)

Pursuant to MPEP 2001.06(b) reference is made to the following United States patent applications filed by the Applicant herein that disclose subject matter related to that embodied in the instant patent application. Reference is also made to the information cited in each respective patent application, such information being compiled in the collection submitted together with the Substitute PTO Form 1449 identified by individual tab numbers.

1. U.S. Patent Application Serial No. 648,032, filed 9/6/84 by Maglica for "Miniature Flashlight" (now U.S. Patent No. 4,577,263) in which the following references were cited:

U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,599,295	(Tab 57)
U.S. Patent No. 2,915,621	(Tab 62)
U.S. Patent No. 2,931,005	(Tab 63)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)

2. U.S. Patent Application Serial No. 828.729, filed 2/11/86 as a continuation of Serial No. 648,032 by Maglica for "Miniature Flashlight" (now U.S. Patent No. 4,658,336) in which the following references were cited:

U.S. Patent No. 1,584,539	(Tab 20)
U.S. Patent No. 1,680,169	(Tab 26)
U.S. Patent No. 2,016,819	(Tab 31)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,945,944	(Tab 64)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. 4,531,178	(Tab 104)
U.S. Patent No. 4,577,263	(Tab 356)

Other references made of record in this patent application include:

U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,398,238	(Tab 97)

3. U.S. Patent Application Serial No. 034.918, filed 4/06/87 as a continuation of Serial No. 828,729 by Maglica for "Miniature Flashlight" (now abandoned) in which the following references were cited:

U.S. Patent No. 2,176,301 (Tab 34)
U.S. Patent No. 2,339,356 (Tab 44)
U.S. Patent No. 2,530,913 (Tab 54)

4. U.S. Patent Application Serial No. 222,378, filed 7/19/88 as a continuation of Serial No. 034,918 by Maglica for "Miniature Flashlight" (now U.S. Patent No. 4,899,265) and in which the following references are cited:

U.S. Patent No. 1,584,539 (Tab 20)
U.S. Patent No. 1,680,169 (Tab 26)
U.S. Patent No. 2,016,819 (Tab 31)
U.S. Patent No. 2,097,222 (Tab 33)
U.S. Patent No. 2,176,301 (Tab 34)
U.S. Patent No. 2,339,356 (Tab 44)
U.S. Patent No. 2,490,830 (Tab 52)
U.S. Patent No. 2,530,913 (Tab 54)
U.S. Patent No. 2,599,295 (Tab 57)
U.S. Patent No. 2,915,621 (Tab 62)
U.S. Patent No. 2,931,005 (Tab 63)
U.S. Patent No. 2,945,944 (Tab 64)
U.S. Patent No. 3,076,891 (Tab 357)

U.S. Patent No. 4,203,150	(Tab 86)
U.S. Patent No. 4,234,913	(Tab 88)
U.S. Patent No. 4,261,026	(Tab 358)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,329,740	(Tab 93)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,398,238	(Tab 97)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,531,178	(Tab 104)
U.S. Patent No. 4,577,263	(Tab 356)
U.S. Patent No. 4,658,336	(Tab 359)
U.S. Patent No. 4,695,551	(Tab 360)
U.S. Patent No. 4,777,582	(Tab 361)
Australian Patent No. 138,873	(Tab 5)
France Patent No. 2,372,382	(Tab 47)
U.K. Patent No. 411,218	(Tab 13)

Mag Instrument, Inc.
Brochure "Exhibit B," Illus-
trating Flashlight of U.S.
Patent No. 4,286,311 to
Maglica (Tab 403)

5. U.S. Patent Application Serial No. 215,725, filed 7/6/88 by Maglica et al. for "DOUBLE SWITCH MINIATURE FLASHLIGHT" (now U.S. Patent No. 4,823,242) in which the following references were cited:

U.S. Patent No. 1,603,272	(Tab 22)
U.S. Patent No. 2,259,106	(Tab 40)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,327,401	(Tab 92)
U.S. Patent No. 4,577,263	(Tab 356)
U.S. Patent No. 4,656,565	(Tab 406)
U.S. Patent No. 4,658,336	(Tab 359)
U.S. Patent No. 4,733,337	(Tab 407)

6. U.S. Patent Application Serial No. 187,827, filed 4/29/88 by Maglica for "SINGLE CELL FLASHLIGHT" (now U.S. Patent No. 4,864,474) in which the following references were cited:

U.S. Patent No. 2,490,830	(Tab 52)
U.S. Patent No. 2,737,574	(Tab 408)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. 4,504,890	(Tab 409)
U.S. Patent No. 4,531,178	(Tab 104)

U.S. Patent No. 4,581,686 (Tab 367)
U.S. Patent No. 4,658,336 (Tab 359)
U.S. Patent No. 4,725,932 (Tab 410)

Other Publications

Weston, "Mini Flash
Lite", advertisement received
in U.S. Patent & Trademark
Office, July 11, 1949 (Tab 404)

Brinkmann, Micro-Max 1
Package Insert, Copyright
1987, (Photocopies of Flash-
light Included in Package and
Pictures of Disassembled
Flashlight Enclosed) (Tab 405)

7. U.S. Patent Application Serial No. 43,086, filed
4/27/87 by Maglica et al. for "FLASHLIGHT" (now U.S. Patent No.
4,819,141) in which the following references were cited:

U.S. Patent No. 1,559,481 (Tab 18)
U.S. Patent No. 1,568,093 (Tab 19)
U.S. Patent No. 1,599,095 (Tab 21)
U.S. Patent No. 1,680,169 (Tab 26)
U.S. Patent No. 1,680,188 (Tab 27)

U.S. Patent No. 1,680,484	(Tab 411)
U.S. Patent No. 1,768,554	(Tab 412)
U.S. Patent No. 1,769,436	(Tab 29)
U.S. Patent No. 1,905,787	(Tab 413)
U.S. Patent No. 2,051,889	(Tab 414)
U.S. Patent No. 2,097,222	(Tab 33)
U.S. Patent No. 2,210,312	(Tab 36)
U.S. Patent No. 2,229,486	(Tab 38)
U.S. Patent No. 2,298,042	(Tab 42)
U.S. Patent No. 2,341,057	(Tab 45)
U.S. Patent No. 2,493,205	(Tab 53)
U.S. Patent No. 2,530,913	(Tab 54)
U.S. Patent No. 4,151,583	(Tab 82)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,357,648	(Tab 95)
U.S. Patent No. 4,527,223	(Tab 366)
U.S. Patent No. 4,577,263	(Tab 356)

8. U.S. Patent Application Serial No. 356,361, filed 5/23/89 by Maglica for "MINIATURE FLASHLIGHT" (now U.S. Patent No. 4,942,505) in which the following references were cited:

U.S. Patent No. 1,584,539	(Tab 20)
U.S. Patent No. 1,680,169	(Tab 26)

U.S. Patent No. 2,016,819	(Tab 31)
U.S. Patent No. 2,097,222	(Tab 415)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,490,830	(Tab 52)
U.S. Patent No. 2,599,295	(Tab 57)
U.S. Patent No. 2,915,621	(Tab 62)
U.S. Patent No. 2,931,005	(Tab 63)
U.S. Patent No. 2,945,944	(Tab 64)
U.S. Patent No. 3,076,891	(Tab 357)
U.S. Patent No. 4,203,150	(Tab 86)
U.S. Patent No. 4,234,913	(Tab 88)
U.S. Patent No. 4,261,026	(Tab 358)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,329,740	(Tab 93)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,398,238	(Tab 97)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. 4,531,178	(Tab 104)
U.S. Patent No. 4,577,263	(Tab 356)
U.S. Patent No. 4,658,336	(Tab 359)
U.S. Patent No. 4,777,582	(Tab 361)

Australia Patent No. 138873 (Tab 5)
France Patent No. 2,372,382 (Tab 47)
U.K. Patent No. 411,218 (Tab 13)

9. U.S. Patent Application Serial No. 836,975, filed
3/6/86 by Maglica for "FLASHLIGHT" (now U.S. Patent No.
4,656,565) in which the following references were cited:

U.S. Patent No. 2,097,222 (Tab 33)
U.S. Patent No. 2,339,356 (Tab 44)
U.S. Patent No. 2,490,830 (Tab 52)
U.S. Patent No. 2,599,295 (Tab 57)
U.S. Patent No. 2,915,621 (Tab 62)
U.S. Patent No. 2,931,005 (Tab 63)
U.S. Patent No. 4,203,150 (Tab 86)
U.S. Patent No. 4,234,913 (Tab 88)
U.S. Patent No. 4,261,026 (Tab 358)
U.S. Patent No. 4,286,311 (Tab 90)
U.S. Patent No. 4,329,740 (Tab 93)
U.S. Patent No. 4,388,673 (Tab 96)
U.S. Patent No. 4,398,238 (Tab 97)
U.S. Patent No. 4,429,351 (Tab 99)

U.S. Patent No. 4,472,766 (Tab 100)

U.S. Patent No. 4,577,263 (Tab 356)

Australia Patent No. 138873 (Tab 5)

France Patent No. 2,372,382 (Tab 47)

10. U.S. Patent Application Serial No. 177,866, filed 3/23/88 by Maglica for "FLASHLIGHT" (now U.S. Patent No. 4,851,974) in which the following references were cited:

U.S. Patent No. 1,638,716 (Tab 23)

U.S. Patent No. 1,674,650 (Tab 25)

U.S. Patent No. 1,758,835 (Tab 28)

U.S. Patent No. 2,176,301 (Tab 34)

U.S. Patent No. 2,339,356 (Tab 44)

U.S. Patent No. 2,530,913 (Tab 54)

U.S. Patent No. 4,151,583 (Tab 82)

U.S. Patent No. 4,472,766 (Tab 100)

U.S. Patent No. 4,658,336 (Tab 359)

U.S. Patent No. 4,577,263 (Tab 356)

U.S. Patent No. 4,656,565 (Tab 406)

11. U.S. Patent Application Serial No. 553,977, filed 7/16/90 by Maglica for "MINIATURE FLASHLIGHT" (pending) in which the following references have been cited:

None

12. U.S. Patent Application Serial No. 410,965, filed 9/22/89 by Maglica for "MINIATURE FLASHLIGHT" (pending) in which the following references have been cited:

Identical to those presented here.

13. U.S. Patent Application Serial No. 34,845, filed 4/6/87 by Maglica for "FLASHLIGHT" (abandoned) in which the following references were cited:

U.S. Patent No. 4,656,565	(Tab 406)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,176,301	(Tab 34)

B. Information Pursuant to MPEP Section 2001.06(c)

Information Regarding Litigation in which Mag Instrument has Claimed Proprietary Rights with Regard to the Shape, Style and Overall Appearance of the Product for which Design Patent Protection is now being Sought or in which Claims of U.S. Patent No. 4,577,263 and/or U.S. Patent No. 4,658,336 and/or U.S. Patent No.

4,851,974 and/or U.S. Patent No. 4,899,265, which are related to the present application, have been Asserted and/or Challenged.

An International Trade Commission ("ITC") investigation and several U.S. District Court Civil Actions and State Court Actions have been filed, served and are in various stages of litigation which involve U.S. Patent No. 4,577,263 (the "'263 patent") issued on March 18, 1986, from application Serial No. 648,032, and/or U.S. Patent No. 4,658,336 (the "'336 patent") issued on April 14, 1987, from application Serial No. 828,729, and/or U.S. Patent No. 4,851,974 (the "'974 patent"), issued on July 25, 1989, from Application Serial No. 177,866, and/or U.S. Patent No. 4,899,265 (the "'265 patent"), issued on February 6, 1990, from Application Serial No. 222,375, or which involve the shape, style and overall appearance ("SSOA") of the product for which design patent protection is now being sought.

Although applicant's attorneys believe the submission of information regarding these litigation matters is not required, a listing, with a short discussion of each of these proceedings, is included below for whatever purpose the Patent Office wishes to make of the information, and to present the information now in anticipation of the possibility that such disclosure may be asserted as being required prior to the expiration date of any patent which may issue from this

application, to wit:

Mag Instrument, Inc. v. The J. Baxter
Brinkmann International Corporation, et
al.,
Civil Action No. CA3-86-0427-G
United States District Court for the Northern
District of Texas, Dallas Division.

In the Brinkmann ('0427) litigation, Mag Instrument sued Brinkmann for, among other things, trademark infringement, false designation of origin and false description, common law trademark infringement, common law palming off, trademark dilution, unfair competition, and infringement of Mag Instrument's United States Letters Patent No. 4,577,263 ("the '263 patent"). Brinkmann counterclaimed against Mag Instrument for, among other things, a declaration that Mag Instrument has no rights in the SSOA of its MINI-MAGLITE flashlight, and that the '263 patent is invalid, unenforceable and not infringed by Brinkmann.

The case was bifurcated and Mag Instrument's claims with respect to Brinkmann's infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight and related acts of unfair competition were set for trial before a jury in Dallas, Texas. The trial was bifurcated between damage and liability issues and took place during the months of April, May and June 1990, with the jury returning a

verdict for Mag Instrument on the issue of whether Brinkmann had competed unfairly with Mag Instrument. The verdict was returned after instruction by the Court on special interrogatories. The jury was instructed as follows with regard to the doctrine of functionality as it relates to product configurations or designs for which trademark protection is sought:

"A product configuration or design is not entitled to recognition as a trademark if it is functional in the legal sense. A design is legally functional if it is dictated by utilitarian characteristics or by the functions that the product is intended to serve.

The doctrine of functionality acts to separate those configurations that may be protected as trademarks and those designs that the law will not permit any person to appropriate or monopolize. Features that are functional in the legal sense cannot be protected. Stated simply, functionality privileges the copying of designs or features that are functional.

To be considered legally functional, a design or feature must be superior or optimal in terms of engineering, cost or economy of manufacture, quality, or accommodation of utilitarian function or performance. A particular design may serve functions demanded by the product's manufacturer, but it is not thereby rendered legally functional -
- and thus unprotectable as a

trademark -- unless the design is only one of a limited number of equally efficient options and free competition would be unduly hindered by according that design trademark protection.

A design that merely assists in a product or configuration's utility, however, is not legally functional and may therefore be protected.

The ultimate inquiry concerning legal functionality is whether characterizing a feature or configuration as protected will hinder competition or infringe upon the rights of others to compete effectively in the sale of goods.

Functionality in the legal sense is not defined, however, in terms of commercial success or marketing effectiveness, since such a definition would permit a second comer to copy a design whenever it became successful and consumers became accustomed to it. While such copying would no doubt enable the second comer to market its product more effectively, the law does not permit that result.

In determining whether the design of the Mini-Maglite is legally functional, you should consider the functionality of the design as a whole, rather than whether each of its individual features is useful or serves a utilitarian purpose. Functional features that are separately unprotectable can be protected together as part of a trademark. In other words, you are not to consider whether an individual feature of the design falls within

the definition of functional, but whether the whole collection of features taken together is functional in the legal sense."

After that instruction, the jury returned, in part, the following verdict:

QUESTION NO. 1:

Does a preponderance of the evidence show that the shape, style and overall appearance of Mag's Mini-Maglite flashlight is not functional?

INSTRUCTION: Before this question can be answered "Yes," the proof must convince you that the shape, style and overall appearance of the Mini-Maglite flashlight is not functional, as that term has been defined. Unless you are so convinced, the question should be answered "No."

ANSWER: Yes.

The jury ultimately decided that Mag Instrument did not have trademark rights in the SSOA of the Mini-Maglite flashlight because Mag Instrument had not shown that the design was inherently distinctive, in the trademark sense, nor had it acquired secondary meaning. However, the jury did find that Brinkmann had wilfully competed unfairly with Mag Instrument. No judgment was entered upon the verdict as the case was settled by Consent Judgment on validity of the '263 patent and the trademark "Mini Maglite" and a concession that Mag is the

owner of the right in the overall shape, style and appearance. A copy of the docket sheet for this case may be obtained if the Examiner believes it is important to the examination of this application. Also, if the Examiner would like to review any of the pleadings in this case, a copy can be obtained and presented.

The Brinkmann Corporation, Plaintiff vs. Mag Instrument, Inc., Defendant. Mag Instrument, Inc., Counterclaimant, vs. The Brinkmann Corporation, J. Baxter Brinkmann International Corporation, Brinkmann International (Hong Kong), Ltd., D.A. Keller & Associates, John Baxter Brinkmann, Donald A. Keller, and Milly Hall, Counterdefendants.

Civil Action No. 89-450 JSL(RWRx)
United States District Court for the Central
District of California.

In the Brinkmann ('450) litigation, Brinkmann filed a complaint containing counts alleging violations of the Sherman Act (Antitrust) alleging that Mag has been monopolizing and is engaged in an attempt to monopolize the machined aluminum flashlight market in the United States (Count I); abuse of process (Count II); and tortious interference with actual and prospective advantage (Count III). A separate complaint by Brinkmann for malicious prosecution was subsequently made a part of this litigation. Mag answered Count III and moved to dismiss Counts I and II under Rule 12, Federal Rules of Civil Procedure. Mag also counterclaimed with ten counts alleging

violations of the Racketeer Influenced and Corrupt Organization Act (Counts I-VI); misappropriation of trade secrets (Count VII); breach of contractual obligations (Count VIII); breach fiduciary duties (Count IX); and interference with prospective advantage (Count X). This case has been settled with the action in Dallas, Civ. Action No. CA 3-86-0427-G referred to above.

Mag Instrument, Inc. v. Central Purchasing, Inc.,
Civil Action No. CV-89-4668 ER (JRx)
United States District Court for the Central
District of California.

In the Central Purchasing ('4668) litigation, Mag Instrument sued Central Purchasing for infringement of its '263 patent and the '336 patents. Central Purchasing answered and counterclaimed for, among other things, a declaratory judgment that Mag Instrument's '263 and '336 patents are invalid and unenforceable. The litigation has settled, and the Court has entered a Consent Judgment and Permanent Injunction that the '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent Judgment is attached hereto as Tab 370.

Mag Instrument, Inc. v. Dayton-Hudson Corporation,
Civil Action No. 89-0529 ER (JRx)
United States District Court for the Central
District of California.

In the Dayton-Hudson ('0529) litigation, Mag Instrument sued Dayton-Hudson for infringement of Mag Instrument's '263 and '336 patents. Dayton-Hudson answered and counterclaimed for, among other things, a declaratory judgment that Mag Instrument's '263 and '336 patents are invalid and unenforceable. The litigation has settled, and the Court has entered a Consent Judgment and Permanent Injunction that the '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent Judgment is attached hereto as Tab 371.

Mag Instrument, Inc. v. Gila Products Ltd.,
Civil Action No. 89-CV-7802
United States District Court for the Southern
District of New York.

In the Gila ('7802) litigation, Mag Instrument sued Gila for, among other things, infringement of its '263 and '336 patents and infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight. The litigation has settled, and the Court has entered a Consent Judgement that Mag Instrument's '263 and '336 patents are valid, enforceable and

were infringed, and that Mag Instrument's trademark in the SSOA of its MINI-MAGLITE flashlight is inherently distinctive, non-functional and has acquired secondary meaning, is valid and enforceable throughout the United States and that Gila has infringed Mag Instrument's SSOA trademark; a copy of the Consent Judgment is attached hereto as Tab 372.

Mag Instrument, Inc. v. Jadico, Inc.,
Civil Action No. 89-4259-CV-C-9
United States District Court for the Western
District of Missouri.

In the Jadico ('4259) litigation, Mag Instrument sued Jadico for infringement of Mag Instrument's '263 and '336 patents. The litigation has settled, and the Court has entered a Consent Judgment that Mag Instrument's '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent Judgment is attached hereto as Tab 373.

Mag Instrument, Inc. v. Jadico, Inc.,
Civil Action No. 89-4260-CV-C-9⁵
United States District Court for the Western
District of Missouri.

In the Jadico ('426) litigation, Mag Instrument sued Jadico for, among other things, infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight. The litigation has settled, and the Court has

entered a Consent Judgment that Mag Instrument's trademark in the SSOA of its MINI-MAGLITE flashlight is inherently distinctive, non-functional and has acquired secondary meaning, is valid and enforceable throughout the United States and has been infringed; a copy of the Consent Judgment is attached hereto as Tab 374.

Mag Instrument, Inc. v. Jomira/Advance, Inc.,
Civil Action No. C-89-20286
United States District Court for the Northern
District of California.

In the Jomira ('20286) litigation, Mag Instrument sued Jomira for infringement of Mag Instrument's '336 patent. The litigation has settled, and the Court has entered a Consent Judgment that Mag Instrument's '336 patent is valid, enforceable and has been infringed; a copy of the Consent Judgment is attached hereto as Tab 375.

Mag Instrument, Inc. v. Jomira/Advance, Inc.,
Civil Action No. C-89-20447
United States District Court for the Northern
District of California.

In the Jomira ('20497) litigation, Mag Instrument sued Jomira for, among other things, infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight. The litigation has settled, and the Court has

entered a Consent Judgment that Mag Instrument's trademark consisting of the SSOA of its MINI-MAGLITE flashlight is inherently distinctive, has acquired secondary meaning and is valid and enforceable throughout the United States and has been infringed; a copy of the Consent Judgment is attached hereto as Tab 376.

In the Matter of Certain Small Aluminum
Flashlights and Components Thereof,
Investigation No. 337-TA-254
United States International Trade Commission,
Washington, D.C.

On September 10, 1986, the ITC initiated Investigation No. 337-TA-254 (the "ITC Investigation") regarding infringement of the '263 patent and Mag Instrument's claim of proprietary rights in the SSOA of its Mini-Maglite flashlight. In expressing its views concerning an initial determination ("ID") by administrative law judge ("ALJ") J. Mathias, which was issued on August 11, 1987, and is attached hereto as Tab 377, with respect to the patent issues, the Commission determined:

1. to reverse the ID's conclusion that the '263 patent is invalid for public use of the claimed invention more than one year prior to the date of filing of the patent application;
2. to find that the '263 patent has not been shown to

be invalid by reason of the claimed invention being on sale more than one year prior to the date of filing of the patent application;

3. to affirm the ID's finding that the '263 patent is not invalid for obviousness over the prior art references other than the prototype flashlight at the two August 1983 trade shows;
4. to not adopt the ID's determination that the '263 patent is invalid for obviousness over the prototype flashlight at the two August 1983 trade shows;
5. to affirm the ID's determination that the '263 patent is unenforceable for inequitable conduct in the prosecution of the '263 patent before the Patent and Trademark Office;
6. assuming arguendo that the patent claims are enforceable, to modify and affirm as modified the SD's determination of patent infringement.

The views of the Commission is attached hereto as

Tab 378.

The ALJ had found that the SSOA of the Mini-Maglite flashlight could not qualify for trademark protection, as follows:

1. Utilitarian Features

The overall shape and configuration of the barrel of the Mini-Maglite is obviously utilitarian. Since it must accommodate two cylindrical AA batteries laid end to end, and also serve as a handle for the flashlight, its shape and length is very much functional. The cylindrical shape is also most convenient for manufacture. (FF 524-29). The diamond knurling on the barrel is functional (FF 530-32) and was common on the barrels of flashlights before the introduction of the Mini-Maglite. (FF 465).

The design of the tail cap is similar to that on predecessor flashlights. (FF 466). Moreover, the design of the tail cap on the Mini-Maglite is particularly utilitarian since it is designed to accommodate an extra bulb. (CPX 278). There are significant design constraints in the fashioning of the tail cap since it should be the same diameter as the barrel. (FF 533-35).

The head assembly of the Mini-Maglite is similarly functional. (FF 536-48). The principal option that the designer may have had was the

nature of the tapering from the lens cap to the barrel. (FF 536-48; CPX 62-74)). However, even here the gradual curved tapering exhibited in the Mini-Maglite has a very practical purpose. Its length and diameter are greatly dependent on functional factors and its shape is particularly well adapted to its intended use. (FF 546-48). The gradual curved tapering also has a functional significance because of the practice of imprinting logos on the heads for some purchasers. This shape provides the maximum surface, with the least printing distortion, for imprinting logos on the flashlight head. (FF 553-59).

The internal switching mechanism of the Mini-Maglite also makes the design quite functional, as this design provides fewer problems with sealing out moisture than does a design using an external switch. It also allows for switching and focusing the light in one action. (FF 552).

The sum total of these component parts add up to the total configuration of the Mini-Maglite. It is this total, overall configuration which determines functionality from a common law

trademark standpoint. Textron, Inc. v. U.S.I.T.C., 753 F.2d 1019, 1025-26 (Fed. Cir. 1985). Aside from the obvious similarity to the older D-cell and C-cell flashlights previously on the market (FF 454-63, 482), the Mini-Maglite's gradually tapered head (claimed in a utilitarian patent), placed on top of a cylindrical barrel that houses two cylindrical, standard-sized AA batteries, with a cylindrical, fitted tail cap on the end, can hardly be claimed to be non-functional in overall configuration. The evidence adduced by complainant has not shown otherwise.

The ITC decided not to review this part of the ALJ's decision and it became the view of the Commission. Various of these issues, but no trademark issues, were appealed to the U.S. Court of Appeals for the Federal Circuit, Appeal No. 88-1313, Mag Instrument, Inc., Appellant v. The United States International Trade Commission, Appellee: Kassnar Imports, Inc.; Brinkmann Corporation; Brinkmann International (Hong Kong). Ltd.; and J. Baxter Brinkmann International Corporation, Intervenor.

In an unpublished opinion, attached as Tab 379, dated

February 15, 1989, the Federal Circuit stated that "the ITC's holding that the ['263] patent is unenforceable due to inequitable conduct was an abuse of discretion . . . and reversed the ITC's holding in that regard.

Subsequently, Intervenor Kassnar Imports, Inc. petitioned the Federal Circuit for rehearing to consider its invalidity arguments, in particular those directed to the issue of public use under 35 U.S.C. 102(b). In an order dated March 21, 1989, the Federal Circuit granted Kassnar's petition to enable consideration of its arguments, but then ordered that its prior February 15, 1989 opinion be amended to add a paragraph explaining that "Kassnar has failed to persuade us that the ITC's decision on this issue is not supported by substantial evidence."

On September 26, 1989, the ITC issued a General Exclusion Order, which, in pertinent part provides that:

Small aluminum flashlights and components thereof which directly or contributorily infringe claims 1, 2, 3 or 4 of U.S. Patent No. 4,577,263 are excluded from entry into the United States for the remaining term of that patent, except under license from the patent owner.

A copy of the General Exclusion Order and the Notice of Issuance of General Exclusion Order are submitted herewith as

Tabs 381 and 380, respectively.

A copy of the docket sheets for the ITC regarding this ITC Investigation may be obtained if the Examiner believes it is important to an examination of this application. Also, if the Examiner would like to review a copy of any of the pleadings in this case a copy will be obtained and presented.

Kassnar Imports, Inc. v. Mag Instrument, Inc.,
Civil Action No. 86-0802-FFF (MCx)
United States District Court for the Central
District of California.

In the Kassnar ('0802) litigation, Kassnar sued Mag Instrument for slander, violation of the antitrust laws of the United States and a declaratory judgment that Mag Instrument has no rights in the SSOA of its MINI-MAGLITE flashlight. Kassnar's antitrust claims were dismissed. Mag Instrument counterclaimed for, among other things, infringement of its '263 and '336 patents. Mag Instrument also sued Kassnar for, among other things, false designation of origin, unfair competition, and related activities based upon Kassnar's infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight. By Summary Judgment those claims were decided adversely to Mag Instrument, the Court deciding that the ITC decision collaterally estopped Mag Instrument from asserting its SSOA claim. The case went to the

Court for decision on the '263 and '336 patents.

In its Conclusions of Law dated January 6, 1989, the U.S. District Court for the Central District of California held that:

Aside from the effect of any public use or sale of the invention, neither the '263 nor the '336 patent is invalid since the invention was not obvious in light of the prior art Conclusion of Law 5.

* * *

Since there was no public use of the invention more than one year prior to September 6, 1988, (sic) nor was the invention on sale prior to that date Conclusion of Law 6.

* * *

. . . Mag was not guilty of any inequitable activity before the Patent Office regarding public use or on sale matters or any other matters. Conclusion of Law 8.

* * *

The '263 patent is valid and enforceable. Conclusion of Law 9.

* * *

The '336 patent is valid and enforceable. Conclusion of Law 10.

In regard to Kassnar Imports, Inc., Plaintiff v. Mag Instrument, Inc., Defendant and Mag Instrument, Inc., Counter-

claimant vs. Kassnar Imports, Inc., Counterdefendant, Civil Action No. CV-86-0802 (Mag v. Kassnar), a copy of the District Court's Statement of Uncontroverted Facts and Conclusions of Law relating to the findings of infringement and also the District Court's Opinion; Findings of Fact and Conclusions of Law and Judgment are submitted herewith as Tabs 383, and 382, respectively. Any deleted portions in the documents relate to certain business confidential information of Mag Instrument, Inc. which caused the District Court to seal the Opinion portion of the document.

The trial court's opinion in pertinent part, stated as follows:

The flashlight industry in the United States is an old one. By the 1980's, it was also a rather moribund one. It had a very slow growth rate, and virtually nobody in the industry foresaw any major changes in that. (See testimony of Dr. Gerald Ford.) One of the reasons was that there were really very few well-designed and well-made flashlights available to consumers. That was particularly true in the area of small flashlights. An examination of the physical exhibits presented here underscores that point.

In the last quarter of 1983, Mag Instrument, Inc. (hereinafter "Mag") began showing a prototype of a new small flashlight. The product was completed and came to fruition in 1984. The flashlight was called the

Mini-Maglite. It was a small aluminum flashlight that took two AA batteries.

The Mini-Maglite was the invention of Anthony Maglica (hereinafter "Mr. Maglica."). It was such an elegant piece of engineering, and was manufactured to such high quality standards that it took the industry by storm. A once sleepy backwater in the economy became a segment with an extraordinary growth rate. The success went against all of the conventional wisdom of the industry and actually revolutionized it. This product has been called a textbook example for those who are interested in analyzing the business sector. (Testimony of Dr. Gerald Ford.)

Of course, that kind of success would not go unnoticed. Many others decided to get into the market, and some of them decided to do so in a rather easy way. They decided to copy the Mag product, or at least to do so as closely as was legally permissible. Kassnar Imports, Inc. (hereinafter "Kassnar") was one of those. That activity on the part of Kassnar resulted in this litigation.

Kassnar claims that the '263 patent [No. 4,577,263] is invalid because it was obvious from the prior art, even aside from the Mini-Maglite prototypes. Kassnar also takes the position that if the '263 patent falls on these grounds, the '336 patent must also fall. Mag objects to this latter position on grounds that the specific issue was not preserved in the Pretrial Conference Order. In any event, it is moot,

since the Court finds the '263 patent to be valid. The Court's discussion will, therefore, concentrate on the '263 patent.

Patents are presumed to be valid. 35 U.S.C. § 282, and those who would attack them must convince the Court by the use of clear and convincing evidence. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1375 (Fed. Cir. 1986), cert. denied, 107 S.Ct. 1606 (1987).

A patent will be invalid: "if the differences between 'he subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103. In Graham v. John Deere Co., 86 S.Ct. 684, 694 (1966), the Supreme Court further explained this test in the following manner:

Under § 103, the scope and content of the prior art to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

See, also, Environmental Designs. Ltd. v. Union Oil Co., 713 F.2d 693 (Fed. Cir. 1983), cert. denied, 104 S.Ct. 709 (1984).

Secondary considerations include commercial success, the filling of a long felt need in the industry, the failure of others to solve the problems, and the fact that the challenger has recognized the merit of the invention. Ralston Purina Co. v. Far-Mar-Co., Inc., 586 F.Supp. 1176, 1222-24 (D. Kansas 1984), rev'd on other grounds, 772 F.2d 1570 (Fed. Cir. 1985).

* * *

It might be noted that the typical pre-Mini-Maglite flashlights . . . show that those working in the field were a very long way from solving the problems that Mr. Maglica solved with his invention.

Of course, there were many flashlights, and there are also many patents for those lights, their switching mechanisms, and their focusing mechanisms. It was surely a somewhat crowded field in that sense. The Mini-Maglite is, however, considerably different from any of those, even if one can point to some elements of the Mini-Maglite in some of those past references. No references would enable one to design the Mini-Maglite, and no one even came close to doing so before that product came on the scene.

It simply is not proper to retrospectively sift through a myriad of patents, discover a little bit here and a little bit there, and

conclude that the new invention is not new at all. See United States v. Adams, 86 S.Ct. 708, 714-15 (1966). An approach of that type would show a kind of hostility to patentability and a kind of hindsight that should not be permitted. At some level, it can be said that there is nothing new under the sun, but that does not mean that we should turn off the lights in the Patent Office and go home. See Santa Fe-Pomeroy, Inc. v. P & Z Co., Inc., 569 F.2d 1084, 1094 (9th Cir. 1978).

Here, by that kind of picking and choosing, Kassnar appears to conclude that the only thing truly new about the invention is the bi-pin lamp, which, it seems to the Court, is hardly the heart of this invention. Rather, the evidence indicates it is a way of obtaining a rather concentrated and exactly positioned light source, which is very desirable.

Thus, Kassnar plucks from one invention (Exhibit 3038) the fact that someone once thought of moving (sliding) the head of a flashlight forward to focus it. From another it plucks the notion that part of the head can screw in a direction (down) to make contact). (Exhibit 3039). From still another, it finds that the whole head can be screwed (down). (Exhibit 482). Again, it discovers a method of focus where in the bulb structure is moved and the switching contact is also made with a ratcheting wheel. (Exhibit 3010). It also plucks from a lantern design the idea that by turning a bezel (up) a spring-loaded contact will light a bulb and focusing can take place.

(Exhibit 483).

This will not do, where, as here, at worst what Mr. Maglica did was develop a wholly new configuration of elements that might be found buried here and there in the prior art.

Before going to a final consideration of these points, however, the fourth factor (secondary considerations) must also be analyzed more specifically. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). These considerations, as already alluded to, combine with the others to make it even more clear that the invention was not obvious.

There can be no doubt that there was a long felt need for an invention of this type (see, e.g., ITC testimony of Dominique Sumian of May 19, 1987). Mr. Sumian indicated that all other solutions to the problem of a flashlight that could be used in scientific expeditions had proved to be unworkable. The Court has already noted the flashlight's extraordinary commercial success, which also suggests that consumers had a long felt need for just such a product -- one that would allow a manufacturer to offer the advantages of the internal switch and focusing and compactness in a durable and well-made light. While Kassnar points out the fact that the product was well-made, and suggests that led to its success, that does not undermine the fact that the invention itself allowed the item to become what it was.

The above is further underscored by the fact that Kassnar did not simply seek to put out a nice-looking or even well-made flashlight. It, instead, copied the internal workings as well as the external appearance. Kassnar well knew that the invention was a great contribution to the success of the flashlight; it recognized the merit of the invention.

In fine, as Mr. George Price, a flashlight manufacturer, testified, this was the greatest thing to hit the industry in twenty-nine years. That was confirmed by the findings of Dr. Gerald Ford. This creation of Mr. Maglica astonished and revolutionized the flashlight industry.

Taking all of the John Deere elements together, the Court will therefore find that Kassnar has failed to show that the '263 patent is invalid because of references in the prior art. That failure extends to the '336 patent.

In regard to the testimony of Mr. George Price, on November 4, 1988, Mr. Price testified, in pertinent part, as follows:

The Clerk: . . . Please state your full name and spell your last name for the record.

The Witness: George Thomas Price,
The Third

Q. Mr. Price, what do you do for a living?

A. Manufacture flashlights.

Q. How long have you done that?

A. 29 years.

Q. When did you first begin manufacturing machined aluminum flashlights?

A. May 1955.

Q. What flashlights did you manufacture before that?

A. Manufactured a complete line of plastic flashlights; mainly military, private label, that type of thing.

* * *

Q. Do you consider Mr. Maglica an expert in the flashlight field?

A. Yes, I do.

Q. Is there a standard in the industry for Double-A-sized machined aluminum flashlights?

A. The Mini-Mag.

Q. Why do you consider it to be a standard of the industry?

A. Well, I know of -- I know it was the first, to my recollection, in the field. It met with instantaneous success. It was considered a high-quality unit and it served a very definite need.

Q. What impact did the Mini-Maglite flashlight have on the flashlight industry?

A. Well, my own feeling was that it was the greatest thing to happen in the flashlight industry in my 29 years that I was manufacturing flashlights.

See transcript pages 77-80 of the testimony of George Price, copies of which are attached hereto as Tab 384.

Regarding the testimony of Dr. Ford, on November 2, 1988, Dr. Ford testified, in pertinent part, as follows:

* * *

Q. Now, have you studied Mag's growth pattern for sales of Mini-Maglite flashlights?

A. I have?

Q. How would you describe that?

A. Well, sales patterns for the Mini-Mag flashlight, as I suspect others will testify to, were dramatic and phenomenal. It was introduced in 1984. And subsequent to that introduction, its impact on the market provided for -- well, let me backup for a moment.

In 1984, the premium flashlight market segment that had been growing previously at the rate of approximately 7 percent a year grew by almost 40 percent between 83 and 84 and subsequently by an additional 25 percent between 84 and 85.

At that same time, the nonpremium segment, this disposal market segment that I discussed earlier grew between 83 and 84 only 5 percent and between 84 and 85 at

approximately 3 percent.

The overall market was -- the overall market growth was up at this time. In fact, the premium market and the slower growth rate, if you will, for the disposal market.

Interestingly enough, this growth actually created a change in the entire market, where prior to the introduction of the Mini-Mag flashlight, approximately 70 percent of the market, in terms of retail dollars, was contained in the disposal lower-priced, lower quality flashlights. And by 1985 that represented only 57 percent of the entire market. So the market was substantially altered after the introduction of the Mini-Maglite if you're looking at the composite flashlight market.

Mag sales were dramatic. I suspect you--discounting the fact or starting it in 1984, after the introduction and looking at 84-85 sales, the Mag was experiencing an average compound growth of ten times the rate of even the premium segment of the flashlight market, which was growing at a compound rate of about 16 percent.

Q. How would you describe the impact of the Mini-Maglite flashlight on the flashlight market?

A. Well, I suspect that this little flashlight ultimately is the kind of product that marketing textbooks and marketing examples are made of.

See transcript of the testimony of Dr. Ford, a copy of which is

submitted as Tab 385.

A copy of the U.S. District Court's docket sheet may be obtained if the Examiner believes it is important to an examination of this application. Also, if the Examiner would like to review a copy of any of the papers referred to in the docket sheet a copy will be obtained and presented upon request.

Subsequently, Kassnar filed a petition in bankruptcy under Chapter 7. Pursuant to 11 U.S.C. Section 362(a), the filing of a petition in bankruptcy invokes an automatic stay prohibiting the commencement or continuation of all judicial proceedings, and all acts to create liens, to collect or enforce claims, or to recover property. Kassnar eventually dissolved as an entity and an appeal from the District Court's decision was dismissed.

Mag Instrument, Inc. v. K-Mart Corporation,
Civil Action No. CV-89-1203 ER (JRx)
United States District Court for the Central
District of California.

In the K-Mart litigation ('1203), Mag Instrument sued K-Mart for infringement of Mag Instrument's '263 and '336 patents. The litigation has settled, and the Court has entered a Partial Consent Judgment that the '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent

Judgment is attached hereto as Tab 387.

Mag Instrument, Inc. v. Long's Drug Stores of
California, Inc.,
Civil Action No. C 619,212
Superior Court of the State of California for the
County of Los Angeles.

In the Long's ('619,212) litigation, Mag Instrument sued Long's for breach of contract, fraud and deceit, negligence, and unfair competition based upon Long's palming-off of non-Mag products as Mag products. The case has settled, and the Court has entered a Consent Judgment; a copy of the Consent Judgment is attached hereto as Tab 388.

Mag Instrument, Inc. v. Oshman's Sporting Goods
Civil Action No. 90 1310
United States District Court for the Central
District of California.

In the Oshman's ('1310) litigation, Mag Instrument sued Oshman's for infringement of Mag Instrument's '263, 336, '974 and '265 patents. The case has settled with all patents declared valid.

Mag Instrument, Inc. v. Outdoor Sports
Headquarters, Inc.,
 Civil Action No. C-3-89-411
 United States District Court for the Southern
 District of Ohio, Western Division.

In the Outdoor Sports ('411) litigation, Mag Instrument sued Outdoor Sports for infringement of Mag Instrument's '263 and '336 patents. The litigation has settled, and the Court has entered a Consent Judgment that Mag Instrument's '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent Judgment is attached hereto as Tab 389.

Mag Instrument, Inc. v. Outdoor Sports
Headquarters, Inc.,
 Civil Action No. C-3-89-410
 United States District Court for the Southern
 District of Ohio, Western Division.

In the Outdoor Sports ('410) litigation, Mag Instrument sued Outdoor Sports for, among other things, infringement of its trademark consisting of the shape, style and overall appearance of its MINI-MAGLITE flashlight. The litigation has settled, and the Court has entered a Consent Judgment that Mag Instrument's trademark in the SSOA of its MINI-MAGLITE flashlight is inherently distinctive, non-functional and has acquired secondary meaning, is valid and enforceable throughout the United States and has been infringed; a copy of the Consent Judgment is attached hereto as Tab 390.

Mag Instrument, Inc. v. Sav-on Drugs, a subsidiary
of American Drug Stores, Inc.
Civil Action No. 89-4305 ER (JRx)
United States District Court for the Central
District of California.

In the Sav-On ('4305) litigation, Mag Instrument sued Sav-On for infringement of Mag Instrument's '336 patent. Sav-On has answered. This case has settled with the patent declared valid and infringed.

Mag Instrument, Inc. v. Sears, Roebuck & Company,
et al.,
Civil Action No. 90 C 868
United States District Court for the Northern
District of Illinois, Eastern Division.

In the Sears ('2216) litigation, Mag Instrument sued Sears for trademark infringement, false designation of origin, unfair competition, common-law trademark infringement, and dilution based upon Sear's infringement of Mag's rights in the SSOA of its MINI-MAGLITE flashlight and related actions for infringement of its trademarks MAG-LITE and MINI-MAGLITE. Defendant Sears has answered and filed a third-party complaint for, among other things, indemnification against its suppliers: Atlas, The Brinkmann Corporation and Dorcy International. The case has settled with a Consent Judgment.

Mag Instrument, Inc. v. Sears, Roebuck & Company,
Civil Action No. CV-89-0972 ER (JRx)
United States District Court for the Central
District of California.

In the Sears ('0972) litigation, Mag Instrument sued Sears for infringement of its '263 and '336 patents. Sears answered, counterclaimed and filed a third-party complaint for indemnification from its suppliers: Atlas, The Brinkmann Corporation and Dorcy International. Dorcy International has settled with Mag Instrument and the Court has entered a Consent Judgment against Dorcy that Mag Instrument's '263 and '336 patents are valid and enforceable, have been infringed by Dorcy and enjoined Dorcy from further acts of patent infringement; a copy of the Consent Judgment is attached hereto as Tab 391. Mag Instrument and Sears have also settled the litigation and the Court has entered a Consent Judgment; a copy of the Consent Judgment is attached hereto as Tab 392.

Mag Instrument Inc. v. Streamlight, Inc.,
Civil Action No. 85-6104 SVW (Kx)
United States District Court for the Central
District of California.

In the Streamlight litigation ('2145) Mag Instrument sued Streamlight for breach of the Settlement Agreement entered

into between Mag Instrument and Streamlight with regard to Streamlight's infringement of Mag Instrument's proprietary rights in the SSOA of its MINI-MAGLITE flashlight upon which the Court had entered a Consent Judgment, which is attached as Tab 393. The Court bifurcated the breach of contract claim from a written circumferential inscription claim and the case went to a jury, which returned a verdict favorable to Mag.

Streamlight filed a petition in bankruptcy, that petition having been filed on February 13, 1989, in the United States Bankruptcy Court in Philadelphia, and therefore all proceedings were stayed. The Bankruptcy Court, upon stipulation of the parties, removed the stay for the limited purpose of permitting Streamlight to file an appeal. Streamlight has recently emerged from the bankruptcy proceeding, as discussed subsequently, and the case has been settled.

Mag Instrument, Inc. v. Streamlight, Inc.,
Civil Action No. 87-02530 ER (JRx)
United States District Court for the Central
District of California.

In the Streamlight ('02530) litigation, Mag Instrument sued Streamlight for infringement of its '336 patent. Streamlight counterclaimed against Mag Instrument for a declar-

ation that the '336 patent is invalid, void, and unenforceable and for declaration that Streamlight has not infringed the '336 patent. As stated previously, Streamlight filed a petition in bankruptcy and the litigation was stayed for some period of time. Prior to Streamlight's filing the petition for reorganization and upon motion by Mag Instrument, Inc., the Court, in an order dated December 12, 1988 granted partial summary judgment of infringement of the '336 patent by various of Streamlight's flashlights. Also, prior to filing its petition for reorganization, Streamlight moved for partial summary judgment of patent invalidity under 35 U.S.C. § 102(b) and for patent unenforceability. The Court denied both of Streamlight's motions. The litigation has settled, and the Court entered a Consent Judgment that the '336 patent is valid, enforceable and has been infringed; a copy of the Consent Judgment is attached as Tab 394.

A copy of the docket sheet for this may be obtained if the Examiner believes it is important to an examination of this application. Also, if the Examiner would like to review a copy of any of the pleadings in this case a copy will be obtained and presented upon request.

Mag Instrument, Inc. v. Streamlight, Inc.
Civil Action No. CV-90-1469R
United States District Court for the Central
District of California.

In the Streamlight ('1469) litigation, Mag Instrument sued Streamlight for infringement of its '265 patent. The litigation has settled, and the Court has entered a Consent Judgment that the '265 patent is valid, enforceable and has been infringed; a copy of the Consent Judgment is attached as Tab 395.

Mag Instrument Inc. v. Trak Auto Corporation,
Civil Action No. 89-4248 ER (JRx)
United States District Court for the Central
District of California.

In the Trak Auto ('4248) litigation, Mag Instrument sued Trak Auto for infringement of Mag Instrument's '263 and '336 patents. Trak Auto answered the complaint and counterclaimed for a declaratory judgment that Mag Instrument's '263 and '336 patents were invalid, void, unenforceable and had not been infringed by Trak Auto. The litigation has settled, and the Court has entered a Consent Judgment and Permanent Injunction that the '263 and '336 patents are valid, enforceable and were infringed; a copy of the Consent Judgment is attached hereto as Tab 396.

Mag Instrument, Inc. v. U.S. Sales Corporation
Civil Action No. 90 3686 WJR(Kx)
United States District Court for the Central
District of California.

In the U.S. Sales litigation, Mag Instrument sued U.S. Sales for infringement of the '263 and '336 patents and infringement of its trademark consisting of the SSOA of its Mini-Maglite flashlight. The litigation has settled and the Court has entered a Consent Judgment that the '263 and '336 patents are valid, enforceable and were infringed by U.S. Sales and that Mag Instrument's trademark in the SSOA of its MINI-MAGLITE flashlight is inherently distinctive, non-functional and has acquired secondary meaning, is valid and enforceable throughout the United States and that U.S. Sales has infringed Mag Instrument's trademark; a copy of the Consent Judgment is attached hereto as Tab 397.

Mag Instrument, Inc. v. Vidor Gunrunner, Inc.,
Case No. C 652,240
Superior Court of the State of California for the
County of Los Angeles.

In the Vidor Gunrunner ('652,240) litigation, Mag Instrument sued Vidor Gunrunner for trademark infringement, dilution, counterfeiting, palming off, unfair business practices, false advertising, and unfair competition. Vidor answered Mag Instrument's complaint but did not counterclaim.

The litigation has settled pursuant to a Consent Judgment which is attached hereto as Tab 402.

Section 282 Notices Regarding United States Federal District Court Litigation in Which Claims of the '263 and/or '336 Patents Have Been Asserted and/or Challenged.

Under 35 U.S.C. Section § 282 in actions involving validity or infringement of a patent, the party asserting invalidity or noninfringement shall give notice of the state of the art in the pleadings or otherwise in writings to the other party at least 30 days before trial.

In this regard and pertaining to the United States Federal District Court litigation referred to in the preceding section, several of the civil actions have progressed to the point where the party asserting invalidity or noninfringement provided notice under Section § 282 of the state of the art. Listed below are the civil actions in which § 282 notices have been served on attorneys for Mag Instrument, Inc.

1. Mag Instrument, Inc., Plaintiff, v. J. Baxter Brinkmann International Corporation, The Brinkmann Corporation and J. Baxter Brinkmann, Defendant and The Brinkmann Corporation, Counter-Claimant v. Mag Instrument, Inc., Counter-Defendant, Civil Action No. CA 3-86-427 G

A "Notice Pursuant to 35 U.S.C. § 282 dated August

1988, has been served. A copy is supplied herewith, as Tab 401.

2. Kassnar Imports, Inc., Plaintiff v. Mag Instrument, Inc., Defendant and Mag Instrument, Inc., Counterclaimant vs. Kassnar Imports, Inc., Counterdefendant, Civil Action No. 86-0802 FFF.

In the Kassnar litigation, Kassnar filed with the court two notices under Section 282. Those notices are as follows:

1. "Plaintiff's Notice of Prior Art Publications [35 U.S.C. § 282]", dated January 26, 1987.
A copy is supplied herewith, as Tab 399.
2. "Plaintiff's Amended Notice of Prior Art Publications [35 U.S.C. § 282]", dated March 24, 1987. A copy is supplied herewith, as Tab 400.

3. Mag Instrument, Inc., Plaintiff vs. Streamlight, Inc., Defendant, No. CV-87-02530 (FFF).

In the Mag v. Streamlight civil litigation, Streamlight filed a "Statement Under 35 U.S.C. § 282" dated February 2, 1989. A copy is supplied herewith, as Tab 398.

4. Other Litigation

None of the other United States Federal District Court civil litigation actions discussed above have progressed to the point where § 282 notices were required.

In regard to the ITC proceeding, no separate pleadings designated as § 282 Notices have been filed, although various references to the state of the art were made in other pleadings such as in answers to interrogatories, in depositions and were made in testimony at the ITC hearing, as referred to above and as set forth in the docket sheets.

Other items in addition to those included by tab number are referenced in the § 282 notices. The specific items found in the various § 282 notices, which are not previously and specifically cited and discussed in the above-identified application, are not now discussed and copies are not provided. However, should the Examiner wish to review any one or more of such publications, physical exhibits or testimony, to the extent available, a copy will be provided upon request.

Included herein as Lists A, B and C from each of the above-identified pieces of litigation are Schedules filed by the respective defendants in accordance with the requirements of 35 USC § 282:

LIST A.

(Mag Instrument, Inc. v. Streamlight, Inc.).

U.S. Patent No. 1,109,415	(Tab 16)
U.S. Patent No. 1,116,048	(Tab 362)
U.S. Patent No. 1,584,539	(Tab 20)
U.S. Patent No. 1,674,650	(Tab 25)
U.S. Patent No. 1,680,169	(Tab 26)
U.S. Patent No. 2,016,819	(Tab 31)
U.S. Patent No. 2,097,222	(Tab 33)
U.S. Patent No. 2,173,650	(Tab 363)
U.S. Patent No. 2,259,106	(Tab 40)
U.S. Patent No. 2,272,907	(Tab 41)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,490,830	(Tab 52)
U.S. Patent No. 2,599,295	(Tab 57)
U.S. Patent No. 2,915,621	(Tab 62)
U.S. Patent No. 2,931,005	(Tab 63)

U.S. Patent No. 2,945,944	(Tab 64)
U.S. Patent No. 3,737,649	(Tab 73)
U.S. Patent No. 3,829,676	(Tab 75)
U.S. Patent No. 3,835,272	(Tab 364)
U.S. Patent No. 4,060,723	(Tab 79)
U.S. Patent No. 4,114,187	(Tab 81)
U.S. Patent No. 4,203,150	(Tab 86)
U.S. Patent No. 4,234,913	(Tab 88)
U.S. Patent No. 4,261,026	(Tab 365)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,329,740	(Tab 93)
U.S. Patent No. 4,357,648	(Tab 95)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,398,238	(Tab 97)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. 4,527,223	(Tab 366)
U.S. Patent No. 4,531,178	(Tab 104)
U.S. Patent No. 4,581,686	(Tab 367)
U.K. Patent No. 292,836	(Tab 12)
U.K. Patent No. 411,218	(Tab 13)
U.K. Patent No. 549,104	(Tab 368)

U.K. Patent No. 752,619 (Tab 14)
 U.K. Patent No. 812,980 (Tab 369)

Australian Patent No. 138,873 (Tab 5)
 French Patent No. 2,372,382 (Tab 47)

Publications

- B.A. Pargh Catalog, March 1983
- Panasonic "Battery Operated Appliances" Brochure
- Home & Auto Magazine, November 1, 1980
- Mag Charger Ad, Law & Order Magazine, October 1982
- Mag Charger Ad, Law & Order Magazine, January 1982
- Mag Charger Ad, Law & Order Magazine, March 1983
- "Magnificent" Mag Charger Ad
- "The One . . . That Fits Every Need" Varibeam Ad
- Magazine entitled "Law and Order", Vol. 31, No. 1, January 1983
- Pro Light Catalog
- Kel-lite Product Brochure
- Maglite Ad "The Right Light . . . For the Job"
- Law & Order ad, January 1981
- Tekna Catalog 1982
- Tekna Price Sheets 1978 and 1979

- Other Mag Brochures

Other Items

- Mini-Maglite prototypes
- Mini-Maglite prototype (N. Meinhardt)
- Mini-Maglite prototype (S. Loft is)
- Maglite 3 "D"-Cell flashlight
- Maglite 3 "C"-Cell flashlight
- Mag Charger Flashlight
- Tekna Micro-Light
- Pro-light Mini-light
- La Spirotechnique flashlight
- Hobart flashlight
- Tekna-Lite II
- Petzl Zoom flashlight
- Stellar Light flashlight
- Kel-lite flashlight
- Pro-lite flashlight

LIST B(Mag Instrument, Inc. v. Kassnar Imports, Inc.).

U.S. Patent No. 1,584,539	(Tab 20)
U.S. Patent No. 1,638,716	(Tab 23)
U.S. Patent No. 1,674,650	(Tab 25)
U.S. Patent No. 1,680,169	(Tab 26)
U.S. Patent No. 1,758,835	(Tab 28)
U.S. Patent No. 2,016,819	(Tab 31)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,530,913	(Tab 54)
U.S. Patent No. 2,599,295	(Tab 57)
U.S. Patent No. 2,915,621	(Tab 62)
U.S. Patent No. 2,931,005	(Tab 63)
U.S. Patent No. 2,945,944	(Tab 64)
U.S. Patent No. 4,151,583	(Tab 82)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. Des. 208,940	(Tab 8)

U.S. Patent No. 3,078,761	(Tab 66)
U.S. Patent No. 3,992,596	(Tab 78)
U.S. Patent No. 4,060,723	(Tab 79)
U.S. Patent No. 4,171,534	(Tab 84)
U.S. Patent No. 4,322,782	(Tab 91)
U.S. Patent No. 4,357,648	(Tab 95)
U.S. Patent No. 4,479,171	(Tab 101)

LIST C

(Mag Instrument, Inc. v. J. Baxter Brinkmann
International Corp. and The Brinkmann Corp.)

U.S. Patent No. 1,109,415	(Tab 16)
U.S. Patent No. 1,116,048	(Tab 362)
U.S. Patent No. 1,584,539	(Tab 20)
U.S. Patent No. 1,674,650	(Tab 25)
U.S. Patent No. 1,680,169	(Tab 26)
U.S. Patent No. 2,016,819	(Tab 31)
U.S. Patent No. 2,097,222	(Tab 33)
U.S. Patent No. 2,259,106	(Tab 40)
U.S. Patent No. 2,339,356	(Tab 44)
U.S. Patent No. 2,490,830	(Tab 52)
U.S. Patent No. 2,599,295	(Tab 57)

U.S. Patent No. 2,915,621	(Tab 62)
U.S. Patent No. 2,931,005	(Tab 63)
U.S. Patent No. 2,945,944	(Tab 64)
U.S. Patent No. 4,203,150	(Tab 86)
U.S. Patent No. 4,234,913	(Tab 88)
U.S. Patent No. 4,261,026	(Tab 358)
U.S. Patent No. 4,286,311	(Tab 90)
U.S. Patent No. 4,329,740	(Tab 93)
U.S. Patent No. 4,388,673	(Tab 96)
U.S. Patent No. 4,398,238	(Tab 97)
U.S. Patent No. 4,429,351	(Tab 99)
U.S. Patent No. 4,472,766	(Tab 100)
U.S. Patent No. 4,495,551	(Tab 102)
U.S. Patent No. 4,527,223	(Tab 366)
U.S. Patent No. 4,531,178	(Tab 104)
U.K. Patent No. 292,836	(Tab 12)
U.K. Patent No. 752,619	(Tab 14)
Australian Patent No. 138,873	(Tab 5)
France Patent No. 2,372,382	(Tab 47)

Publications

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- Home & Auto Magazine, November 1, 1980
- Mag Charger Ad, Law & Order Magazine, October 1982
- Mag Charger Ad, Law & Order Magazine, January 1982
- Mag Charger Ad, Law & Order Magazine, March 1983
- "Mag-nificent" Mag Charger Ad
- "The One . . . That Fits Every Need" Varibeam Ad

Other Items

- Mini-Maglite prototypes (Streamlight Exhibits 371, 372, 375)
- Mini-Maglite prototype, N. Meinhardt (CPX-427)
- Mini-Maglite prototype, S. Loftis (BRPX-56)
- Maglite 3 "D"-Cell Flashlight (BRPX-39)
- Maglite 3 "C"-Cell Flashlight (BRPX-40)
- Mag Charger Flashlight (BRPX-47)
- Tekna Micro-Light (CPX-117)
- Eveready 5 "D" -Cell Flashlight

In order to facilitate the Examiner's consideration of the reported items, such items have been arranged hereinafter by Tab number in groups according to particular characteristics involved in the instant flashlight design:

1. Removable Head With Exposed Lamp To Make An Auxiliary
Lantern

000167

2. Head Larger Than Barrel

a) General

000007	000009	000015	000017	000021
000024	000025	000026	000032	000034
000038	000048	000053	000068	000093
000099	000103	000110	000118	000165
000219	000222	000248	000279	000279A
000280	000289	000327	000330	000331
000335	000336	000337	000340	000344
000345	000346	000349	000355	

b) With Conical Transition or Head

000001	000005	000008	000014	000016
000041	000042	000049	000055	000059
000061	000063	000066	000067	000070
000071	000072	000073	000074	000076

000077	000079	000084	000089	000091
000094	000095	000097	000100	000101
000104	000105	000106	000106A	000107
000108	000109	000112	000113	000114
000116	000117	000118	000119	000120
000127	000128	000132	000133	000141
000142	000143	000144	000145	000146
000147	000162	000169	000179	000180
000181	000182	000183	000184	000186
000187	000190	000191	000193	000194
000196	000197	000198	000199	000201
000202	000203	000204	000206	000207
000209	000210	000211	000212	000213
000214	000215	000216	000217	000218
000224	000225	000226	000227	000228
000229	000230	000231	000232	000241
000247	000251	000252	000253	000254
000255	000262	000263	000282	000290
000291	000292	000293	000294	000295
000297	000299	000300	000301	000302
000304	000306	000309	000309A	000321
000334	000338	000348	000351	000353
000354				

c) With Convexly Curved Transition or Head

000002	000003	000006	000010	000011
000013	000018	000019	000029	000031
000033	000036	000043	000044	000045
000058	000060	000062	000064	000065
000075	000078	000080	000082	000083
000086	000090	000096	000098	000111
000113	000114	000115	000120	000121
000122	000123	000124	000125	000126
000128	000129	000130	000131	000132
000133	000134	000135	000136	000137
000138	000139	000140	000148	000149
000150	000151	000152	000153	000154
000155	000156	000157	000158	000159
000162	000163	000165	000167	000168
000170	000171	000172	000173	000174
000175	000176	000177	000178	000188
000189	000190	000192	000205	000208
000219	000220	000221	000223	000233
000234	000236	000237	000238	000239
000240	000242	000243	000244	000245

000246	000249	000250	000256	000257
000258	000259	000260	000261	000264
000265	000266	000267	000268	000269
000270	000271	000272	000273	000274
000275	000276	000277	000278	000281
000283	000284	000285	000286	000287
000288	000296	000298	000303	000307
000308	000310	000311	000312	000313
000314	000315	000316	000317	000318
000319	000320	000341	000342	000343
000350	000352			

d) With Concavely Curved Transition or Head

000004	000012	000022	000028	000037
000047	000054	000055	000069	000219
000221				

3. With External Switch

000001	000007	000008	000009	000010
000011	000015	000017	000018	000020
000021	000025	000026	000037	000038

000042	000043	000045	000048	000053
000054	000057	000058	000059	000060
000062	000063	000064	000066	000067
000068	000069	000070	000074	000075
000076	000077	000078	000079	000080
000082	000083	000084	000085	000089
000090	000091	000095	000096	000097
000098	000103	000105	000106	000107
000108	000109	000113	000114	000115
000118	000120	000121	000123	000124
000126	000129	000130	000131	000132
000133	000134	000135	000136	000137
000138	000139	000140	000141	000142
000143	000144	000145	000146	000148
000149	000150	000151	000152	000153
000154	000155	000156	000159	000162
000165	000167	000168	000171	000176
000177	000178	000193	000195	000196
000198	000199	000201	000202	000204
000205	000206	000207	000208	000210
000211	000212	000213	000214	000216
000217	000218	000219	000220	000221
000222	000224	000225	000226	000227

000228	000229	000230	000231	000232
000233	000234	000236	000237	000238
000239	000240	000241	000242	000243
000244	000245	000246	000247	000248
000249	000250	000251	000252	000253
000254	000255	000256	000257	000258
000259	000260	000261	000262	000263
000264	000265	000266	000267	000268
000269	000270	000271	000272	000273
000274	000275	000276	000277	000278
000281	000282	000283	000284	000285
000286	000287	000288	000289	000290
000291	000292	000293	000294	000295
000297	000298	000299	000300	000301
000302	000303	000304	000306	000307
000308	000309	000309A	000310	000311
000312	000313	000314	000315	000316
000317	000318	000319	000320	000321
000326	000327	000329	000330	000331
000332	000333	000334	000336	000337
000338	000339	000340	000343	000344
000346	000348	000349	000350	000351
000352	000353	000354	000355	

4. Without External Switch

000002	000003	000004	000005	000006
000012	000013	000014	000016	000019
000022	000023	000024	000028	000029
000030	000032	000033	000034	000035
000036	000039	000040	000041	000044
000046	000047	000049	000050	000051
000052	000055	000061	000065	000071
000072	000086	000087	000088	000092
000093	000094	000099	000100	000102
000104	000106	000106a	000148	000157
000194	000203	000279	000279A	000280
000296	000305	000335	000341	000342
000345				

5. Tail Can Larger Than Barrel

000003	000004	000005	000010	000012
000013	000015	000016	000018	000019
000020	000021	000022	000023	000024
000026	000028	000029	000030	000031

000034	000038	000046	000048	000049
000053	000054	000061	000066	000067
000068	000070	000071	000087	000094
000165	000219	000220	000222	000226
000289	000290			

6. Head Not Appreciably Larger Than Barrel

000027	000030	000035	000039	000040
000050	000051	000052	000057	000081
000085	000087	000088	000092	000102
000148	000149	000153	000154	000161
000165	000200	000219	000220	000221
000223	000235	000305	000322	000323
000324	000325	000326	000328	000329
000332	000333	000339	000347	

The documents listed above and on the associated Form PTO-1449 are submitted in accordance with the requirements of 37 CFR 1.97 and 1.98. A review has been made of all documents identified by tab number. The following documents have been identified as being particularly representative of known designs or individually significant which should help the

Examiner in evaluation of the present application:

Tab 6 - U.S. Patent Des. 142,277 to Lippincott, issued August 21, 1945. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and without an external switch.

Tab 11 - U.S. Patent Des. 263,170 to Maglica, issued February 23, 1982. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and with an external switch.

Tab 33 - U.S. Patent No. 2,097,222 to Tompkins et al., issued October 26, 1937. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and without an external switch.

Tab 36 - U.S. Patent No. 2,210,312 to Wood, issued August 6, 1940. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and without an external switch.

Tab 41 - U.S. Patent No. 2,272,907 to Deibel, issued

February 10, 1942. Flashlight(s) having a head larger than the barrel with a conical transition or head and without an external switch.

Tab 42 - U.S. Patent No. 2,298,042 to Desimone, issued October 6, 1942. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 44 - U.S. Patent No. 2,339,356 to Sachs, issued January 18, 1944. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and without an external switch.

Tab 45 - U.S. Patent No. 2,341,057 to Muldoon, issued February 8, 1944. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 58 - U.S. Patent No. 2,769,896 to Lambert, issued November 6, 1956. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 60 - U.S. Patent No. 2,852,634 to Garland, issued September 16, 1958. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 64 - U.S. Patent No. 2,945,944 to Gillespie, issued July 19, 1960. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 78 - U.S. Patent No. 3,992,596 to Miller, issued November 16, 1976. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 79 - U.S. Patent No. 4,060,723 to Nelson, issued November 29, 1977. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 82 - U.S. Patent No. 4,151,583 to Miller, issued April 24, 1979. Flashlight(s) having a head larger than the

barrel with a convexly curved transition or head and an external switch.

Tab 90 - U.S. Patent No. 4,286,311 to Maglica, issued August 25, 1981. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 96 - U.S. Patent No. 4,388,673 to Maglica, issued June 14, 1983. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 105 - Kel-Lite Brochure "World's Finest and Strongest Flashlight". Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 106A - Kel-Lite two-page flyer "The Original Flashlight Made to Last a Lifetime!". Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 120 - Gym Products Brochure "Police Military Outdoorsman Industrial", identified as Exhibit DX5058, 4 pages. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 121 - Lumitek Brochure "Smoke Cutter, Code 4, Luma-Tech", identified as Exhibit BRX203, 11 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 125 - Police Equipment Division advertisement "Flashlights and Accessories", 2 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head.

Tab 126 - Police Equipment Division advertisement "Power Probe Medical Flashlight", identified as Exhibit BRX204, 1 page. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 129 - B-Lite advertisement "America's Finest

Handheld Flashlight", identified as Exhibit DX5043, 1 page. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 130 - B-Lite "For Those Who Demand The Very Best", identified as Exhibit DX5042, 2 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 136 - B-Lite "Bianchi B-Lite", identified as Exhibit 6471, 1 page. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 141 - Safariland Law Enforcement Brochure, identified as Exhibit DX5015, 4 pages. Flashlight(s) having an external switch.

Tab 148 - Sireno "Pro-Light", identified as Exhibit DX5026, 4 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 153 - Pro-Lite "Professional Flashlights", identified as Exhibit DX5031, 15 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 165 - G. T. Price Products, Inc. Brochure "The Professional Line", identified as Plaintiff's Exhibit CX-1431, 9 pages. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch. The tail cap is larger than the barrel.

Tab 167 - Maglite flyer "They demand the very best." Discloses a lantern mode with the head removed and left disassociated from the barrel. The bulb extends from the top of the barrel in a large flashlight with a switch on the side.

Tab 168 - Maglite flyer "Strength and Reliability", identified as deposition Exhibit PX82, 1 page. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 189 - Copy of a photograph of Exhibit DX5629 "Brinkmann", 1 page. Flashlight(s) having a head larger than

the barrel with a convexly curved transition or head.

Tab 205 - Copy of a photograph of six Maglite flashlights, identified as Plaintiff's Exhibit 415. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 207 - Copy of a photograph of Plaintiff's Exhibit 701, flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 226 - Copy of a photograph identified as 5003 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 232 - Copy of a photograph identified as 5009 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 235 - Copy of a photograph identified as 5025 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight having a head which is not appreciably larger than the barrel.

Tab 239 - Copy of a photograph identified as 5035 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 240 - Copy of a photograph identified as 5036 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 241 - Copy of a photograph identified as 5045 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 243 - Copy of a photograph identified as 5049 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 245 - Copy of a photograph identified as 5051 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 266 - Copy of a photograph identified as 5111 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 267 - Copy of a photograph identified as 5112 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and

an external switch.

Tab 284 - Copy of a photograph identified as 5301 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 285 - Copy of a photograph identified as 5302 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 286 - Copy of a photograph identified as 5303 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 301 - Copy of a photograph identified as 5318 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger

than the barrel with a conical transition or head and an external switch.

Tab 302 - Copy of a photograph identified as 5319 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

Tab 319 - Copy of a photograph identified as 6124 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a convexly curved transition or head and an external switch.

Tab 348 - Copy of a photograph identified as CPX 385 illustrating a Coca Cola can (for perspective), a ruler (for size) and a flashlight. Flashlight(s) having a head larger than the barrel with a conical transition or head and an external switch.

The noting of these documents is not a representation that Applicant or his attorneys have considered such documents

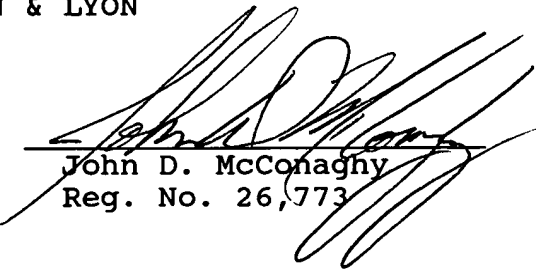
in such depth as to permit a conclusive representation of their relevance but, instead, the representations have been made with the understanding that the Examiner will nevertheless make a thorough investigation of the available information pursuant to the provisions of 37 CFR 1.104.

Respectfully submitted,

LYON & LYON

Date: May 13, 1991

By:


John D. McConaghy
Reg. No. 26,773

34th Floor
611 W. Sixth Street
Los Angeles, CA 90017
(202) 842-8400